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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,526	07/27/2000	Evan D.H. Green	NFC1P004X1	1198

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08/05/2003

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
7TH FLOOR
LOS ANGELES, CA 90025

EXAMINER

JACKSON, CORNELIUS H

ART UNIT

PAPER NUMBER

2828

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/626,526

Applicant(s)

GREEN ET AL.

Examiner

Cornelius H. Jackson

Art Unit

2828

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 88, 89, 91, 92, 97-99 and 101-125 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 88, 89, 91, 92, 97-99 and 101-125 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Paul IP
PAUL IP
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Application Papers

- 9) ☐ The specification is objected to by the Examiner.

- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)

- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

- 5) ☐ Notice of Informal Patent Application (PTO-152)

- 6) ☐ Other: _____.

DETAILED ACTION

Acknowledgement

1. Acknowledgement is made that applicant's Amendments, filed on 19 May 2003, has been entered. Upon entrance of amendment, claims 91, 92, 97, 103, 106, 113 and 115 were amended and claims 90 and 126-128 were cancelled. Claims 88, 89, 91, 92, 97-99 and 101-125 are pending in this application.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2828

4. Claims 88, 89, 91, 92, 97-99 and 101-125 are rejected under 35 U.S.C. 102(b) as being anticipated by Yasuda et al. (4947398). Yasuda et al. disclose a tunable filter apparatus **Fig. 4**, comprising a grid generator **4** positioned in an optical path and configured to generate a first transmission peaks corresponding to channels of a selected wavelength grid; and a channel selector **5** positioned in the optical path and configured to generate a second plurality of transmission peaks, wherein the tunable optical filter enables a portion of the optical signal having a wavelength corresponding to the common wavelength of the aligned transmission peaks to pass through while attenuating portions of the optical signal having other wavelengths, **see Figs. 3a-c and 5, col. 4, lines 10-60 and col. 10, line 45-col. 12, lines 34.**

Regarding claims 89, Yasuda disclose the stated limitation, **see col. 2, line 40-col. 4, line 60.**

Regarding claims 91, 92 and 101, Yasuda disclose all the stated limitation including a gain medium **1, see Fig. 4 and col. 9, lines 43-col. 13, line 20.**

Regarding claims 102-105, Yasuda disclose all the stated limitations, **see Fig. 4, col. 2, line 40-col. 4, line 60, col. 9, lines 43-col. 13, line 20 and col. 10, line 45-col. 12, lines 34.**

Regarding claims 106, Sesko et al. teach the grid generator and the channel selector comprise a Fabry-Perot filter/an interference element, **see abstract, col. 9, lines 43-col. 13, line 20.**

Regarding claim 107-109, 111, 112, 113 and 115, Yasuda disclose all the stated limitations, **see col. 4, line 48-col. 11, line 40 and col. 18, line 23-col. 19, line 11.**

Art Unit: 2828

Regarding claims 97-99 and 116-125, the method of a device is not germane to the issue of patentability of the device itself, since the device itself obviously uses the method. Therefore the rejection used on the device applies also to the method of the device.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 110 and 114 rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al. (4947398). Yasuda et al., as applied to claims 88,89, 91, 92, 97-99, 101-109, 111-113 and 115-125 above, teach all the stated limitations except for the type of etalon used being gas spaced or a grating.

Regarding claims 110 and 114, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

7. Applicant's arguments with respect to claims 88, 89, 91, 92, 97-99 and 101-125 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Note that claims 88, 89, 91, 92, 97-99 and 101-125 of this application conflict with claims 1-28 and 33-36 of Application No. 10/087728 and claims 1-17, 19-34 and 36-54 of Application No. 10/099649. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822. Also see *Zorabedian et al.* (6282215).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cornelius H. Jackson whose telephone number is (703) 306-5981. The examiner can normally be reached on 8:00 - 5:00, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone numbers for the

Art Unit: 2828

organization where this application or proceeding is assigned are (703)308-7722 for regular communications and (703)308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

Chj

chj
July 22, 2003

Paul IP

PAUL IP
SUPERVISORY PATENT EXAMINER
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